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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/670,815

09/25/2003

Paul Moulton

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7590

08/14/2006

BAKER & BOTTS  
30 ROCKEFELLER PLAZA  
44TH FLOOR  
NEW YORK, NY 10112

EXAMINER

HORTON, YVONNE MICHELE

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/670,815	<b>Applicant(s)</b> MOULTON ET AL.	
	<b>Examiner</b> Yvonne M. Horton	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31-37 and 41 is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-15, 17-21, 23, 24, 26-30, 38 and 40 is/are rejected.
- 7) ☒ Claim(s) 9, 16, 22, 25 and 39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed 04/07/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: there is support in the specification for the width of the lateral wings being "substantially" larger than the height. Although the drawing figures show a difference in the length and the height, there is no mention of this in the specification and no reasons supporting this amendment.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10,26 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites that the width of the lateral wings is "substantially" larger than the height of the lateral wings; however, all that is encompassed by "substantially" is not clear. For instance, "substantially" larger with regards to what circumstances (i.e. the distance of the gap between the concrete members, the amount that the compressible members are required to be compressed, etc.). The specification merely states that the

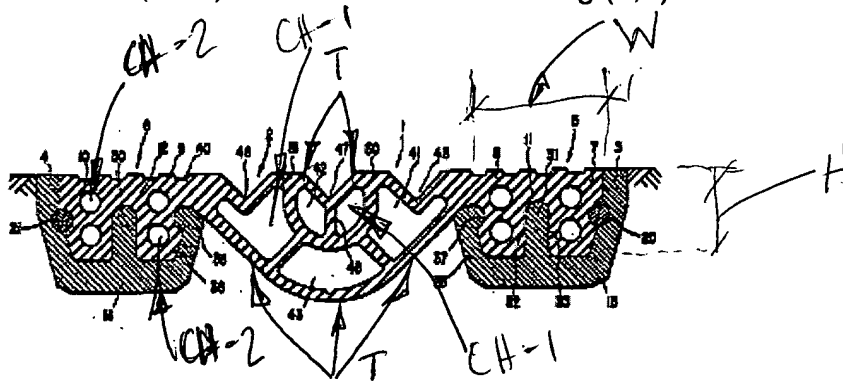
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larger block out widths ease placement of the smaller lateral wings during placement of the compression seals. The specification does not detail the specifics of the width and length of the lateral wings or reasons for the length being "substantially" larger than the width.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,2,5-8,10,26,30 stand and 38,40 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #4,637,085 to HARTKORN. Regarding claims 1,38 and 40, HARTKORN discloses the use of a compression seal for an expansion joint (1) between two adjacent elements (15,16) including a compressible sealing portion (2) having an elastic membranes (T,48) and at least a lateral wing (5,6)



extending therefrom and extruded as one-piece therewith; wherein the lateral wings, have a width (W) and a height (H) such that the width (W) is larger than the height (H) and a thickness (TH) that is larger than the thickness of the elastic membranes (T,48) and are configured to be bonded to a surface of the adjacent elements (15,16).

Regarding the 35 U.S.C.112 rejections above, the applicant has shown no criticality for the length of the lateral wings being 'substantially' larger than the width of the wings.

Clearly, the lateral wings and compressible sealing portion of HARTKORN function equivalently to the instant seal in that the distance between adjacent structures is sealed and maintained there between while being able to accommodate expansion and contraction of the space between the adjacent structures. In reference to claim 2, HARTKORN discloses that his wings (5,) have a thickness of 3.5 cm that converts to 1.37 inches and is at least a half of an inch. Regarding claims 5 and 6, the compressible sealing portion includes a membrane having longitudinal tubes/channels (CH-1) that extends along the length thereof and are inherently known to aid in varying the lateral width of the member. Regarding claims 7 and 8, the lateral wing portion (5,6) includes longitudinal channels (CH-2) and grooves (as at 40). In reference 10, the compressible seal of HARTKORN has the same cross-sectional configuration throughout. Regarding claims 26 and 30, as mentioned earlier, the "tubes/channels" (CH-1) inherently change or deform in order to vary the width of the device.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3 and 4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #4,637,085 to HARTKORN in view of US Patent #5,213,441 to BEARVELDT. HARTKORN discloses the basic claimed compression seal except for explicitly detailing the type of rubber material used to form the seal. BEARVELDT teaches that it is known in the art to use EPDM rubber to form a compressible sealing member. Although BEARVELDT does not explicitly detail ethylene propylene

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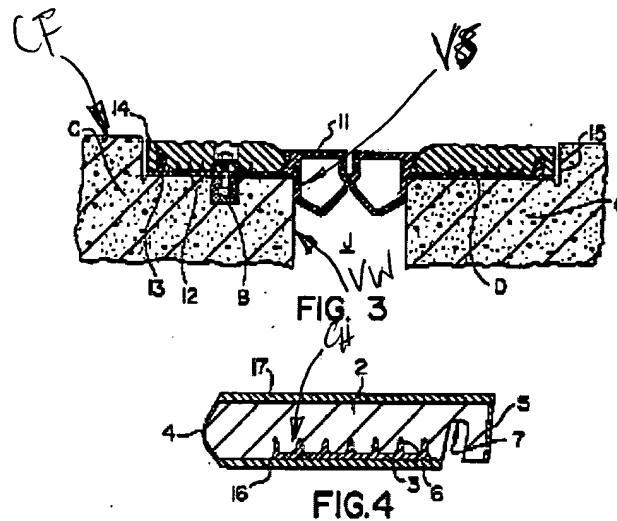
tetrapolymers, as per the applicant's own disclosure and from what is known by one having skill in the art, ethylene propylene tetrapolymers, in trade, is referred to as EPDM. Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the compression seal of HARTKORN out of the EPDM material of BEARVELDT in order to provide stability, carry a torque and to accommodate different lengths in joint sizes.

Claims 11-15, 19-21, 23, 25 and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,584,152 BAERVELDT in view of 4,637,085 to HARTKORN. BAERVELDT discloses the use of an expansion system including an expansion joint (J) disposed between adjacent concrete elements (C) of a structure; a one-piece compression seal having a compressible sealing portion (11) having an elastic membranes (T) and at least a lateral wing (12) extending laterally from a top portion (TP) of the compressible seal (11); and a block-out region (letter (e) column 4) such that the block-out region is adapted to receive the lateral wing (12) and is bonded thereto. BAERVELDT discloses the basic claimed expansion joint system except for the lateral wings having a thickness larger than the thickness of the elastic membranes. HARTKORN teaches that it is known in the art to form lateral wings (5,6) of a compression seal (1) such that the thickness of the lateral wings (5,6) is larger than the thickness of the elastic membranes (T, 48). Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the compression seal of BAERVELDT with lateral wings having a larger thickness than the elastic membranes, as taught by HARTKORN in order to enhance the rigidity of the joint

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seal. Regarding claim 12, BAERVELDT discloses the use of a block-out region (as at 15) that has a thickness slightly greater than the lateral wing thickness (12). In reference to claim 13, HARTKORN teaches that his wings (5,) have a thickness of 3.5 cm that converts to 1.37 inches and is at least a half of an inch. In reference to claims 14 and 15, BAERVELDT discloses that his lateral wings (12) are bonded by adhesives and is bolted as at (B) to the block-out regions (column 4, letter (h)). Regarding claim 19, the compressible sealing portion includes longitudinal tubes (CH-1) that extends along the length thereof. In reference to claim 20, the compressible sealing portion includes a membrane having longitudinal tubes/cavities (CH-1) that extends along the length thereof and are inherently known to aid in varying the lateral width of the member. Regarding claims 21, the lateral wing portion (5,6) includes longitudinal channels (CH-2). In reference 23, the compressible seal of BAERVELDT has the same cross-sectional configuration throughout. In reference to claim 25, the concrete elements (C) include a floor (CF), and a vertical wall (VW) wherein the compressible sealing portion (11) includes vertical side walls (VS) that are bonded to the vertical walls (VW) of the concrete floor (CF). Regarding claim 28, the "tubes/channels" (CH-1) inherently change or deform in order to vary the width of the device.

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Claims 17 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,584,152 to BAERVELDT in view of 4,637,085 to HARTKORN, as applied to claim 11 above, and further in view of US Patent #5,213,441 to BAERVELDT. BAERVELDT '152 discloses the basic claimed compression seal except for explicitly detailing the his rubber material used to form the seal is EPDM. BEARVELDT '441 teaches that it is known in the art to use EPDM rubber to form a compressible sealing member. Although BEARVELDT '441 does not explicitly detail ethylene propylene tetrapolymers, as per the applicant's own disclosure and from what is known by one having skill in the art, ethylene propylene tetrapolymers, in trade, is referred to as EPDM. Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the compression seal of BAERVELDT '152, as modified by HARTKORN, out of the EPDM material of BEARVELDT '441 in order to provide stability, carry a torque and to accommodate different lengths in joint sizes.

***Allowable Subject Matter***



Claims 9,16,22,25 and 30 remain and claim 39 is objected to as being allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 31 remains as being allowed, and claims 32-37 and 41 are allowed.

### ***Response to Arguments***

Applicant's arguments filed 04/07/06 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the sealing body "alone") are not recited in the rejected claim(s). Even though claims 32 and 33 include "consisting of", claim 1 does not. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

Regarding the applicant's argument that the device of HARTKORN does not have a height sufficient to plug open-topped sills, clearly HARTKORN details a seal that has a height surely "sufficient" to "plug" between the open-topped sills (S), see above. HARTKORN, column 1, lines 56-63, clearly details that the width and thickness of his member serves to "better" secure the member in place.

In reference to the applicant's argument that HARTKORN is not a one-piece device, clearly the device of HARTKORN, includes a joint spanning construction (1) and sills (5,6); however, the claim is directed to a "compression seal". Clearly the device (1)

of HARTKORN is "one-piece". However, the applicant is reminded that claim 40 includes "comprising" which is allowed to include other elements such as the sill members. "Consisting" is not exclusive only to the compression seal alone.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, BEARVELDT '441 is only introduced to teach the use of EPDM, ethylene propylene tetrapolymers in the art of compression seals.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (571) 272-6845. The examiner can normally be reached on 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YMH 

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